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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,444	03/12/2004	Dwight Allen Merriman	11032/3069	5265
23838 7590 06/09/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER GOLDMAN, MICHAEL H				
ART UNIT 3688		PAPER NUMBER		
MAIL DATE 06/09/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/798,444

Applicant(s)

MERRIMAN ET AL.

Examiner

MICHAEL H. GOLDMAN

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.136

1. A request for continued examination under 37 CFR 1.136, including the fee set forth in 37 CFR 1.17(a) (1), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(a)(1) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.136. Applicant's submission filed on May 2, 2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210).

Claim 1: Goldhaber discloses an apparatus for advertising, comprising:

- a. a processor, memory, and database (column 9, line 33 - column 10, line 8);
- b. collecting information based upon a plurality of advertisement requests sent from a user (column 12, lines 14-37);
- c. selecting an advertisement based upon the collected information (column 14, lines 17-40);
- d. basing the advertisement request on a link on a content request from said user (column 7, lines 28-46 and column 16, lines 6-10); and
- e. updating the available advertisements (column 14, lines 23-31).

While Goldhaber does not explicitly disclose generating a report about the placement of advertisements, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide reports about advertisement placement back to the advertisers. One would have been motivated to provide such reports in view of Goldhaber's disclosure that the problem his invention overcomes is "how will advertisers know that they are getting their money's worth?" (column 5, lines 56-57). Goldhaber further discloses billing the advertiser for the number of "cyber-coins" clicked on by the users. This also implies that the advertiser is receiving a report in order to ascertain both the amount to pay and the basis for the bill.

Claim 2: Goldhaber discloses an apparatus for advertising as in Claim 1 above, and further discloses sending the selected advertisement to the said user for display (column 16, lines 6-10 and column 18, lines 27-33).

Claim 3: Goldhaber discloses an apparatus for advertising as in Claim 2 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 11, lines 16-24 and column 16, lines 6-10).

Claim 4: Goldhaber discloses an apparatus for advertising as in Claim 3 above, and further discloses sending a network address (URL) to the user in response to the click-through request (column 16, lines 57-64).

Claim 5: Goldhaber discloses an apparatus for advertising as in Claim 3 above, and further discloses storing information about a prior click-through from said user (column 7, lines 8-19; column 12, lines 14-37; and column 18, lines 1-2).

Claim 6: Goldhaber discloses an apparatus for advertising as in Claim 1 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 12, lines 14-37 and column 17, lines 1-3).

Response to Arguments

4. Applicant's arguments filed May 2, 2008 have been fully considered but they are not persuasive.

a. The Applicant argues that Goldhaber fails to disclose or suggest a link from an affiliate node to a user node, and a content request from a user node to an affiliate node. Examiner respectfully disagrees, Goldhaber explicitly solves the same problem as applicant (see column 6, lines 24-31) in which a system is provided whereby the link between the ad and the appropriate viewer is provided via reference to a database of digitally stored electronic demographic profiles of potential viewers which are dynamic and interactive. In conjunction with 'orthogonal sponsorship' (see Fig 6 and column 5, lines 43-57) whereby advertising content is decoupled from other content, thereby enabling an affiliate (third party) to respond to a consumer request. Examiner construes 'orthogonal sponsorship' as including affiliate(s), also see column 3, line 51 whereby the internet is a system of linked computers, examiners construes the linked computers to inherently contain affiliate and user nodes to link a content request from a user. Although advertising content is decoupled from other content, consumers, 2nd parties (content providers), and affiliates (3rd parties) are not decoupled as per the 'orthogonal relationship'.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg
June 2, 2008

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688